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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,399	08/09/2000	Lorraine Elisabeth Pena	PUJ-0279	5718

7590 12/22/2004
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EXAMINER

KANTAMNENI, SHOBHA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/634,399

Applicant(s)

PENA ET AL.

Examiner

Shobha Kantamneni

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Page 2.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 3-23, 25, 26, 28-30, 33-36, 38-41, 43-55, 57-62, 64-76, 78, 111-116 and 120-122.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

SHENGJUN WANG
PRIMARY EXAMINER

Continuation of 2: The proposed amendments and the Declaration filed on 10/13/04 are not entered because they are filed after the Final Office Action. There is no indication on record for example in the Interview summary dated 14, June 2004 that these amendments will be considered after final.

Continuation of 7: Applicant argue's that "Although Preuilh indicates that Pemulen TR1, Pemulen TR2, Carbopol 1342 and Carbopol 1382 may be used to emulsify a two-phase system, there is nothing in the reference to suggest that these polymers are suitable for use as gelling and/or thickening agents". This argument is not persuasive because 1) it is not commensurate in scope with the instant composition claims, and 2) the composition and its properties are inseparable.

Applicant argue's that "Although the reference broadly teaches that the compositions can comprise from 0.0001 % to 20 % by weight of the active agent, and contains no teachings that the active agent must be present at a concentration which is less than its solubility limit in the composition, as is the case with the presently defined compositions". This argument is not persuasive because Preuilh composition contains the active agent such as minoxidil in the same amount as that of the instant invention, it must be present at a concentration which is less than its solubility limit.

Applicant argue's that " the emphasis in Ewers is clearly not on the selection of a particular delivery formulation, but rather on the reported benefits of esterification of the active agent". Examiner agrees that Ewers is directed to a composition for transdermal delivery of estrogens and respectfully points out that Ewers reference was relied upon for his teachings that emulsion gels and single phase gels are used in transdermal composition forms for applying such compositions to the skin.

Applicant argue's that " Although Pena describes 3 % minoxidil single phase gels, such gels are prepared with Carbopol 934P, a carbomeric thickening agent. The present claims define compositions in which the thickening agent is other than Carbopol 934P". Examiner respectfully points out that Applicant has argued against the reference individually , when the rejection was made over combination of references.

Applicant argue's, "Preiulh teaches that these non-carbomeric polymers may be used as emulsifiers, not as thickening agents.....Thus, in following the combined teachings of Preuilh and Pena, the skilled artisan would be expected to utilize a carbomeric thickening agent such as Carbopol934, which is taught by both Preuilh and Pena". This argument is not persausive because Preuilh teaches the use of PEMULEN TR1, PEMULEN TR2 in the composition containing minooxidil.